

REMARKS/ARGUMENTS

With entry of the amendment, claims 2-4, 18, 20 and 22 are pending in this application. Claims 6, 8-10, 12, 19 and 21 are canceled and claims 2, 4 and 20 are amended as set forth in detail herein. Claim 22 is newly added. Claims 1, 5, 7, 11, and 13-17 were previously canceled. No new matter is added. Applicant reserves the right to pursue any canceled subject matter in a related, co-pending application. In view of the these amendments and the remarks below, reconsideration of the application is respectfully requested.

Claim Amendments

Independent claim 2 has been amended to delete the phrase "a neurodegenerative disorder of a cranial nervous system" and to recite the phrase "a candidate of" and "wherein said tissue comprises surviving or normal cells." Support for "a candidate of" is found, *e.g.*, at page 13, lines 16-20 of the specification and support for "surviving and normal cells" is found, *e.g.*, at page 3, and page 11, lines 19-22 of the specification. Applicant has further amended claim 2 to incorporate the limitation of claim 6, namely, claim 2 now specifies that the disorder is Alzheimer's Disease. Accordingly, claim 6 has been canceled.

Claim 4 has been amended to delete the word "before."

Claims 8-10, 12, 19 and 21 are canceled.

New claim 22 is added. Support for claim 22 is found, *e.g.*, at page 35, line 36 of the specification.

These amendments are made for purposes of expediting prosecution of the instant application and should not be construed as agreement with or acquiescence to any rejection.

Claim Rejections Under 35 U.S.C. § 112, second paragraph

Claims 4, 8, 10, 19 and 21 stand rejected under 35 U.S.C. § 112, second paragraph, as allegedly indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention.

The Examiner states that claim 4 is indefinite "because it is not clear how cell death can be induced *before* the suppression of cell death is detected." (See Final Office Action at page 3.) It is respectfully submitted that one skilled in the art would understand that there is a time-lag between induction of cell death and actual cell death. A skilled artisan would appreciate that the Applicant intends a method wherein cell death is induced, but cell death of at least a portion of cells is delayed until after the expression of a test nucleic acid in step (a). These cells will survive when the transgene has a suppressive effect on cell death. Accordingly, Applicant submits that the claim language of claim 4 is clear and definite. Nonetheless, to advance the prosecution, claim 4 has been amended by deleting the word "before." Claim 10 has been canceled.

Reconsideration and withdrawal of the 35 U.S.C. § 112, second paragraph rejection of claim 4 are respectfully requested.

The Examiner further states that, "claim 8 is vague and indefinite in that the metes and bounds of a 'tissue of a nerve' are unclear." Claim 8 has been canceled, so the rejection of claim 8 is moot.

Claim Rejections Under 35 U.S.C. § 112, first paragraph

Claims 2, 4, 6, 8, 10, 12 and 18-21 stand rejected under 35 U.S.C. § 112, first paragraph, as allegedly failing to comply with the written description requirement. The Examiner states that the claims are rejected for reasons on record. The Applicant respectfully traverse this rejection.

The Examiner alleges that the concept underlying the invention requires the use of surviving or normal cells in or near the area of pathological cell death. This allegation has been rendered moot by amending the claim to specify that nucleic acids are isolated from a tissue that contains surviving or normal cells and the tissue is from an area of the brain having undergone cell death.

The Examiner also alleges that remarks in the specification at p. 3, lines 24-27 constitute an admission that the methods of the invention may not generally be effective. It is

respectfully submitted that the Examiner is not viewing this remark in its proper context. This remark occurs before and provide contrast to the inventor's description of his insight of isolating suppressor genes, namely that they can be found from slightly affected or normal cells in the vicinity of damaged tissues. Thus, whereas before the present invention, diseases tissues or organs would not have usually have been thought of as a fertile ground for isolating disease suppressor genes, the present application provides a general solution that allows disease suppressor genes to be identified notwithstanding such doubts.

Notwithstanding the generality of the disclosed invention, present claim 2 has been further amended to recite a tissue of a brain of an organism suffering from Alzheimer's Disease, wherein said tissue is obtained from an area of the brain showing cell death as a pathological feature of Alzheimer's Disease. (Emphases added.) The specification discloses an expression library prepared from the tissue recited by claim 2. (See Example 1 of the specification.) Using the library, 36 non-overlapped clones showing suppressive effect on AD-associated cell death have been isolated. (See Example 2 of the specification.) Thus, the claimed subject matter is described in the specification.

Applicant also submits that particularly in view of the present claims referring to Alzheimer's Disease (AD), the examples given in the specification are representative of how the method is be used in identifying other AD-associated cell death-suppressive genes. As discussed, Example 2 of the specification provides evidence that at least 36 non-overlapped clones showing suppressive effect on AD-associated cell death are isolated based on the claimed method.

The Examiner further alleges that "Indeed, even in Applicant's working example(s), a suppression of cell death has only been observed *in vitro*, and the detection of a suppressive effect on Alzheimer's disease itself has not been tested." (See page 14, lines 19-22 of the Final Office Action.)

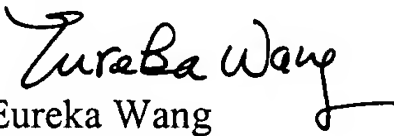
Applicant respectfully submits that the present claims are directed to a method of screening for a candidate suppressor gene rather than a method of treating Alzheimer's Disease. In other words, the present claims provide a method to screen for candidate genes that have the

possibility of suppressing cell death; the present claims do not require that every gene identified by the methods ultimately prove to be a useful gene for treating Alzheimer's Disease. Rather, it is sufficient that the methods allow one to isolate candidate genes for this purpose from a much larger repertoire. Thus, Applicant submits that further testing to detect suppression of Alzheimer's disease in vivo is not required. It is respectfully submitted that Applicant has demonstrated possession of the present claims as is evidenced in the Examples of the specification.

Therefore, for at least the reasons above, the presently amended claims comply with the written description requirement under 35 U.S.C. § 112, first paragraph. Withdrawal of the present rejection is respectfully requested.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 650-326-2400.

Respectfully submitted,


Eureka Wang
Reg. No. 50,510

TOWNSEND and TOWNSEND and CREW LLP
Two Embarcadero Center, Eighth Floor
San Francisco, California 94111-3834
Tel: 650-326-2400
Fax: 415-576-0300
Attachments
JOL:YEW:yew
61098193 v1